

1115.65380



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re U.S. Patent Application)

Applicant: Karakawa et al.)

Serial No. 09/820,537)

Filed: March 29, 2001)

For: INFORMATION STORAGE
APPARATUS...)

Art Unit: 2651)

I hereby certify that this paper is being deposited with the United States Postal Service as FIRST-CLASS mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on this date.

April 8, 2002

Date
F-CLASS.WCM

Appr. February 20, 1998

Registration No. 47,954

Attorney for Applicant

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TRANSMITTAL

Assistant Commissioner for Patents
Washington, DC 20231

Technology Center 2600

Sir:

- (X) Enclosed is an IDS, PTO Form 1449 and cited references to be filed in the above-referenced application.
- (X) Copy of German Office Action with translation.
- (X) If a Petition under 37 C.F.R. §1.136(a) for an extension of time for response is required to make the attached response timely and does not separately accompany this transmittal, Applicant(s) hereby petition(s) under 37 C.F.R. §1.136(a) for an extension of time for response in the above-identified application for the period required to make the attached response timely.
- (X) The Commissioner is hereby authorized to charge any additional fees which may be required to this application under 37 C.F.R. §§1.16-1.17, or credit any overpayment, to Deposit Account No. 07-2069. A duplicate copy of this sheet is enclosed.

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GREER, BURNS & CRAIN, LTD.

By:

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April 2, 2002

Date
F-CLASS WCM

Registration No. 47,954

Appr. February 20, 1998

Attorney for Applicant

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INFORMATION DISCLOSURE STATEMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In accordance with 37 C.F.R. §§1.56, 1.97 and 1.98, Applicants through counsel herewith submit copies of the publications as set forth in the attached form PTO-1449 as follows:

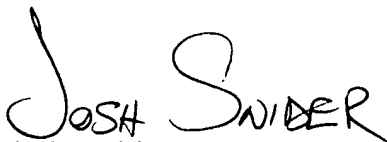
FOREIGN PATENT DOCUMENTS

<u>DOCUMENT NO.</u>	<u>COUNTRY</u>	<u>PUBLICATION DATE</u>
903 731	Japan	Mar 24, 1999
316 188	Japan	May 17, 1989

Applicants respectfully request that the Examiner consider the above-listed references in the examination of this application and list these references of record in the application.

Respectfully submitted,

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- 1) EP 0903731 A2/A3; G11B-007/00
- 2) EP 0316188 A2/A3; G11B-011/10

1.)

On the 22.5.01 Applicants effectively submitted an examination request in the present application. This request is based on the originally filed (application date 21.5.01) documents as present documents.

The following remarks are made on these documents:

2.)

2.1) According to the present claim 1 the application proceeds from prior art as already disclosed in publication 1) (EP 0903731 A2/A3). For this publication also relates to an "information storage apparatus" (cf. publication 1, title page).

2.2) However, publication 1 also discloses the following features of the one-part claim 1, i.e. that such an information storage apparatus is further equipped with:

- a) "a mark reading section for reading a mark written on an information storage medium, said information storage medium having a recording area which is divided into a plurality of regions on which information is recorded by writing a mark, and from which information is reproduced by reading the recorded mark" (cf.

publication 1, title page, and the introduction to the description, pages 1 and 2. The structuring of the optical data carrier, for example in regions, follows from the fact that the data carrier according to publication 1 can also be used for writable digital storage disks, and it is generally known of these that they may also have sectors, blocks or regions);

and

- b) "a recording state changing section for changing a recording state in an adjacent region" (since the disk according to publication 1 can also be written on and erased (cf. pages 1 and 2) such a "recording state changing section" is to be presumed).

Since in the present case it is readily possible to set forth a separation of features known from one publication from additional features within the scope of a claim 1 having a two-part wording and such a wording most strikingly and clearly shows the difference from the nearest prior art, such a clear wording of the statement of claim is also to be adopted in the present case.

The present claim 1 is not allowable for the simple reason that it is not adequately limited with respect to the nearest prior art according to publication 1.

- 2.3) The following assessment is made of the remaining features of claim 1:

There remains in claim 1 the features that the information storage apparatus is further characterised in

- c) that in the adjacent region "situated next to a faulty region from which of a plurality of regions the mark reading section fails to read a mark so that crosstalk can be reduced caused by the adjacent region should the mark reading section fail on reading the mark"
- c) "said mark reading section again reading a mark in the faulty region after changing of a recording state in the adjacent region by the recording state changing section".

The above steps are no doubt intended to achieve that if information is recorded in the adjacent region erasure of the information on the basis of a change in the recording state can be avoided (for example by crosstalk) by evacuating the information prior to the change of the recording state in the adjacent zone and thereafter restoring said information (cf. also the text in the description, page 6, lines 24 to 29). This content can however be worded considerably more clearly and more precisely in claim 1.

Claim 1 is therefore not allowable because of lack of adequately complete and clear technical teaching.

- 2.4) Otherwise, Applicants' arguments regarding the differences from the prior art can be substantially

accepted. It would therefore be possible to arrive at an allowable claim 1 by appropriate limitation and more exact wording of the present claim 1.

However, the present claim 1 is not allowable because of the defects referred to above.

3.)

3.1) Claim 1 (sic!) has similar defects to claim 1 and is therefore likewise not allowable in the wording and feature scope claimed.

3.2) After removal of claims 1 and 10 claims 2 to 9 and 11 to 18 appended to these claims are not allowable either. Since these claims contain however at least expedient further developments of the subject of the application according to claim 1, they would likewise be allowable as subclaims to allowable claims.

3.3) As relevant prior art attention is drawn provisionally to publication 2) (EP 0316188 A2/A3). Publication 2) also deals explicitly with the optical means for reading and writing from and onto optical record carriers (cf. Figures 1, 1M, 4 and 5) therein).

For an early grant the present statement of claim would have to be revised in accordance with the indications in this Official Action. In addition, the description would have to be adapted to the new statement of claim and the prior art found in the examination proceedings additionally acknowledged in the introduction to the description.

If Applicants do not intend submitting a material response within the term set informal acknowledgement of the receipt of this Official Action is requested.

If the requirements of this Official Action are not met rejection of the application will have to be expected after expiry of the term.

Examiner for Class G11B